



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

100

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,078	12/28/1999	ROY SHKEDI	JMB-2-0003	9573

7590 04/28/2003

FAY SHARPE BEALL
FAGAN MINNICH & MCKEE
1100 SUPERIOR AVENUE
SUITE 700
CLEVELAND, OH 441142518

EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/473,078

Applicant(s)

SHKEDI, ROY

Examiner

Jean D Janvier

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3622

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/24/03 has been entered and a Non-Final Office Action follows.

DETAILED ACTION

Specification

On page 4 and line 8, "one distributors" should apparently be --one distributor--.

Status of the claims

Claims 1-41 are now pending in the Instant Application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3622

Claims 1-4, 6-17 and 19-37 and 38-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Roth, PCT Application WO 98/34189.

As per claims 1 and 27, Roth discloses a method and/or system for providing advertisements from a central server to viewers (10) who access web sites (14) over the Internet based at least in part on the viewers or users (10) characteristics or profile, which match a set of criteria or characteristics associated with the advertisements (16A) from the advertisers or distributors. The central server stores both advertisements (16A), which are to be displayed and an information database (16B). The database or DB (16B) includes information about viewers' profile, information about the characteristics of particular web sites and other information relevant to which advertisements should be displayed for particular viewers (10). Further, proposed bids submitted by different advertisers for the right to display their messages on the viewers' (10) computer screens are evaluated in real time in order to determine which particular advertisement will be displayed to a viewer (10). Each proposed bid can specify a price or amount that the advertiser is willing to pay for the opportunity to display an advertising message or commercial to a computer user or viewer (10) who has a particular set of characteristics (profile) and on a web site (14) having web page (12) that meets a particular set of criteria or conditions. Finally, the system includes a web server (16) having databases, bidding agents (30), which compare the characteristics of view-ops to the specification in proposed bids and which submits bids as appropriate and bid selection logic which decides which bids to accept for each particular view-op (the fact that the viewer has accessed a web page having an HTML reference to the advertising server). Furthermore, the use of a first module, second module, third module,

Art Unit: 3622

fourth module, fifth module and sixth module to perform the tasks outlined in the claims is implicitly or inherently supported in the Roth's reference, as understood by those skilled in the art. Finally, Roth does disclose a bidding system wherein an advertiser may submit multiple bid responses based on the viewer's profile, viewer's previous visits to the advertiser's web site or first visit to the advertiser's web site, the number of click-throughs or traffic generated by the referring web site, etc. meeting the advertiser's criteria to have his advertising messages or advertisements displayed on computer screens of qualified viewers or users (forming a large number of bid combinations). See abstract; figs. 1-7; p3: 2 to p. 5: 3.

Furthermore, it is inherently taught that a user's or visitor's profile such as demographic profile is made of attributes, such as gender, education, geographic location, income, marital status and so on. And when an advertiser is bidding for the right to display his advertising messages to a visitor with the right profile, the advertiser first considers the values of individual attributes within the profile before he decides to make a bid offer (how much money this visitor's profile is worth) for the right to display his advertising messages to the visitor having such profile attributes. Additionally, the visitor's profile may include demographic information, psychographic information, browsing habits information, etc., and the advertiser may choose to display his advertising messages to a visitor having particular characteristics or attributes associated with his profile. For example, the advertiser might bid ten cents for a visitor who had recently visited a particular web page and one cent if the visitor has not visited the web page. In short, determining a bid price for the visitor's profile by considering the value or the importance of each individual attribute within the profile (substantially as the sum of predetermined prices

Art Unit: 3622

for the attributes in the profile) is implicitly supported by Roth (p. 7: 9-14; p. 8: 26 to p.9: 15; p. 10: 5-9).

As per claims 36-37, Roth discloses a method and/or system for providing advertisements from a central server to viewers (10) who access web sites (14) over the Internet based at least in part on the viewers or users (10) characteristics or profile, which match a set of criteria or characteristics associated with the advertisements (16A) from the advertisers or distributors. The central server stores both advertisements (16A), which are to be displayed and an information database (16B). The database or DB (16B) includes information about viewers' profile, information about the characteristics of particular web sites and other information relevant to which advertisements should be displayed for particular viewers (10). Further, proposed bids submitted by different advertisers for the right to display their messages on the viewers' (10) computer screens are evaluated in real time in order to determine which particular advertisement will be displayed to a viewer (10). Each proposed bid can specify a price or amount that the advertiser is willing to pay for the opportunity to display an advertising message or commercial to a computer user or viewer (10) who has a particular set of characteristics (profile) and on a web site (14) having web page (12) that meets a particular set of criteria or conditions. Finally, the system includes a web server (16) having databases, bidding agents (30), which compare the characteristics of view-ops to the specification in proposed bids and which submits bids as appropriate and bid selection logic which decides which bids to accept for each particular view-op (the fact that the viewer has accessed a web page having an HTML reference to the advertising server). Furthermore, the use of a first module, second module, third module, fourth

Art Unit: 3622

module, fifth module and sixth module to perform the tasks outlined in the claims is implicitly or inherently supported in the Roth's reference, as understood by those skilled in the art. See abstract; figs. 1-7; p3: 2 to p. 5: 3.

Furthermore, it is inherently taught that a user's or visitor's profile such as demographic profile is made of attributes, such as gender, education, geographic location, income, marital status and so on. And when an advertiser is bidding for the right to display his advertising messages to a visitor with the right profile, the advertiser first considers the values of individual attributes within the profile before he decides to make a bid offer (how much money this visitor's profile is worth) for the right to display his advertising messages to the visitor having such profile attributes. Additionally, the visitor's profile may include demographic information, psychographic information, browsing habits information, etc., and the advertiser may choose to display his advertising messages to a visitor having particular characteristics or attributes associated with his profile. For example, the advertiser might bid ten cents for a visitor who had recently visited a particular web page and one cent if the visitor has not visited the web page. In short, determining a bid price for the visitor's profile by considering the value or the importance of each individual attribute within the profile (substantially as the sum of predetermined prices for the attributes in the profile) is implicitly supported by Roth (p. 7: 9-14; p. 8: 26 to p.9: 15; p. 10: 5-9).

As per claims 2, 8-9,13-14 and 31-35, Roth discloses an Internet advertising system wherein Web Server 310 of fig. 3 (communication node) receives an HTML reference (a view op) or HTTP request from web browser 12 when the viewer or visitor (10) accesses a web site

Art Unit: 3622

having a link to advertising Web Server or Web Server 310 (page 6: 5-25). If the characteristics of a viewer or visitor (10) meet the criteria of a proposed bid, bidding agent (30) will submit a bid to view server 320 based on a minimum or maximum bid or a fixed amount or budget an advertiser is willing to spend for the right to display his advertising message to a particular viewer (10) having a set of characteristics or profile. After receiving input from bidding agents (30), the bid selection logic 16C in view server 320 selects the highest bid and indicates to the Web Server 310 which advertisement from database (16A) should be displayed in response to the HTTP request. In response to the input from view server 320, the web server 310 delivers the appropriate advertisement to the viewer or visitor (10). It should further be understood that the steps of collecting responses from distributors or advertisers are performed automatically using the bidding agents (30), bid logic 16C, Web Server 310, view server 320 in conjunction with the viewers' profile and the advertisers' or distributors' targeted profile or characteristics and an amount (predetermined threshold) that the advertisers or distributors are willing to pay for a specific targeted profile and wherein the viewers' profile and the advertisers' or distributors' targeted profile are stored in databases corresponding to Web server 310 (page 3: 19 to page 4:10; page 12: 13-17; page 13: 13-23; page 16: 1-9; fig.1; see abstract).

As per claims 3, 7, 10,11-12 and 23-25, Roth disclose a method and/or system wherein bidding agent (30) will submit a bid to view server 320 if the characteristics or profile of a viewer or visitor (10), a human, meet the criteria of a proposed bid from an advertiser or distributor. The visitor's profile contains at least information from web sites previously visited, IP address of the visitor's PC, demographic information provided by the visitor during

Art Unit: 3622

registration, which are stored in database 16B of fig.1. It should further be understood that the visitor will fill out a registration form, containing a plurality of fields including a header, where he will provide his personal information used in determining whether or not his profile or characteristics match the criteria or characteristics specified by an advertiser in a bid (page 1: 23 to page 2: 2; page 3: 23 to page 4: 7; page 13: 13-23; page 15: 11-15; page 15: 20-25; page 36: 4-19; page 37: 23-24; page 15: 11-15).

As per claims 4, 6, 15-17, 19 and 26, it is understood that once it is determined that the visitor's characteristics or profile match the characteristics of a proposed bid from a particular advertiser, Web Server 310 will deliver an appropriate advertisement, in the form of a banner, text, imager, etc., to the visitor and wherein the advertisement contains a hyperlink associated with the advertiser's web site. Upon clicking on the hyperlink, the visitor can visit the advertiser's web site in order to receive more information about an advertised product or even purchase the product or another product (follow-up). The visitor or viewer's interaction with the advertisement is tracked or monitored (audited), thereby making sure that the advertiser's message was actually viewed by the viewer or visitor (10). Visitor's purchases, based at least in part on viewed advertisements, are closely monitored or tracked (audited) and subsequently used to further enhance the visitor's profile wherein this enhanced profile is used in the matching of characteristics by bidding agent (30) or intermediary. Finally, an advertiser can effectively use the tracking or auditing data to decide whether or not a visitor has previously visited his web site and based on this determination, the advertiser might bid more or less money (page 3: 19 to page 4: 10; page 13: 13-23; page 17: 1-2; fig. 1; fig. 6B).

As per claims 20-22, Roth discloses a method for advertising on the Internet wherein a viewer or visitor (10) uses a client to visit web sites over the Internet. A cookie or file stored on the visitor's client or computer collects data regarding the visitor's visits to these web sites and these data are subsequently analyzed and used along with the visitor's personal information to compose a profile for the visitor and wherein this profile is used in the matching of characteristics by bidding agent (30) or intermediary before an appropriate advertisement is sent to the visitor by Web Server 310, thereby eliminating the possibility to send irrelevant or unwanted advertisements to the visitor. Finally, an advertiser can effectively use the tracking or auditing data stored in the cookie to decide whether or not a visitor has previously visited his web site and based on this determination, the advertiser might bid more or less money (page 3: 19 to page 4: 10; page 13: 13-23; page 17: 1-2; page 36: 21 to page 37: 2; fig. 1; fig. 6B).

As per claims 28-30 and 38-41, Roth discloses a method and/or system for providing advertisements from a central server to viewers (10) who access web sites (14) over the Internet based at least in part on the viewers or users (10) characteristics or profile, which match a set of criteria or characteristics associated with the advertisements (16A) from the advertisers or distributors. The central server 16 stores both advertisements in a database (16A), which are to be displayed and an information database (16B) module containing the viewer's profile. The database or DB (16B) includes information about viewers' profile, information about the characteristics of particular web sites and other information relevant to which advertisements should be displayed for particular viewers (10). Further, proposed bids submitted by different

Art Unit: 3622

advertisers for the right to display their messages on the viewers' (10) computer screens are evaluated in real time in order to determine which particular advertisement will be displayed to a viewer (10). Each proposed bid can specify a price or amount that the advertiser is willing to pay for the opportunity to display an advertising message or commercial to a computer user or viewer (10) who has a particular set of characteristics (profile) and on a web site (14) having web page (12) that meets a particular set of criteria or conditions. Finally, the system includes a web server (16) having databases, bidding agents (30), which compare the characteristics of view-ops to the specification in proposed bids and which submits bids as appropriate and bid selection logic which decides which bids to accept for each particular view-op (the fact that the viewer has accessed a web page having an HTML reference to the advertising server). See abstract and fig. 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roth in view of Bezos, US Patent 6,029,141, filed in 1997.

Art Unit: 3622

As per claim 18, Roth does not expressly disclose a method and/or system wherein an agent or a system owner receives a payment or compensation resulting from a visitor at an advertiser's web site specified in an advertisement that was displayed on the visitor's terminal.

However, Bezos discloses a method and/or system for distributing product promotions to the public wherein an agent or associate or Amazon.com partner will set up a web site or associate's web site having a link or referral link to the Amazon.com site or Merchant's web site to recruit visitors or customers. Upon visiting an associate's web site using his PC, a visitor or customer can access information about products, such as books, sold at Amazon.com web site and if the customer or visitor wants to learn more about an advertised product or even make a purchase, he/she can click on the referral link associated with the advertised product. If the customer or visitor purchases the advertised product at the Merchant's web site, the associate will receive a commission or compensation for a successful referral based on some predefined criteria (See abstract; figs 1-2).

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate Bezos' teachings into the Roth's system so as to have an advertiser compensate or pay the owner or agent of the Internet Advertising System for distributing the advertiser's messages to qualified viewers if and only if the viewers make purchases related to the products specified in the advertisements, thereby making the system more attractive to advertisers while eliminating the need for the advertisers to ensure that their messages were actually read by qualified viewers since the system is now a performance based system, that is the owner of the system will not be compensated unless a viewer makes a purchase corresponding to an advertised product.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roth.

Roth does not expressly disclose a method and/or system for at least transferring encrypted advertisements to a visitor.

However, transmitting encrypted data between at least two parties over a network in an effort to secure the transmission of the data so that the data are not tampered with is a well-established business method practiced or used in the industry for many years.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into the Roth's system so as to at least encrypt an advertisement before it is transmitted to a qualified viewer (10), thereby making sure that the advertiser's message or advertisement was not tampered with or the integrity of the advertisement was not comprised in the process (authentication).

Response To Arguments

First of all, Applicant's request for an interview before an Office Action on the merits is issued subsequent to reviewing the amended claims, new claims and remarks submitted by the Applicant has been respectfully denied. It is not a good practice to request an interview to discuss patentability of claims that are not yet examined. This is being referred to in the art as a "fishing expedition". However, upon receiving and reviewing the office action, the Applicant can call the Examiner to schedule an interview.

Moreover, Applicant's arguments or remarks regarding the previous action are very broad and do not present any specific deficiency in the prior art except for the newly amended claims, which were fully addressed in the rejection as described above. Further, the limitations recited in the newly amended claims are clearly disclosed in the Dedrick's reference and Goldhaber's reference (see conclusion section).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5,974,398A to Hanson discloses an advertisement system.

US Patent 5,724,521A to Dedrick. (IDS).

US Patent 5,794, 210 to Goldhaber et al (IDS).

Applicant is further directed to consult these pertinent references.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

Please provide support, that is page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

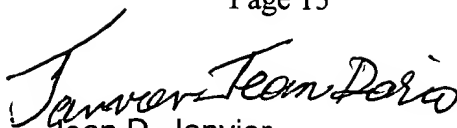
Application/Control Number: 09/473,078

Art Unit: 3622

JDJ

04/23/03

Page 15


Jean D. Janvier

Patent Examiner

Art Unit 3622